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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,197	07/08/1999	DAVID A. MONROE	58959.10.23	7703

7590 11/08/2002

JUDY KRUGER
BRACEWELL & PATTERSON LLP
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HOUSTON, TX 770022781

EXAMINER

CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/350,197

Applicant(s)

MONROE, DAVID A. *DM*

Examiner

WILLIAM D. CUMMING

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-63 is/are pending in the application.
- 4a) Of the above claim(s) 50-55, 57, 59, 60, 62 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-49, 56, 58 and 61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of election of species in Paper No. 17 is acknowledged. The traversal is on the ground(s) that the examiner has no serious burden of examination even though applicant admits that the species "...*may be patentably distinct...*". This is not found persuasive because the examiner determines the burden the examination, not applicant's attorney. Searching and writing possible nine different rejections for nine "...*patentably distinct...*" inventions is prima facie a serious burden to the examiner.

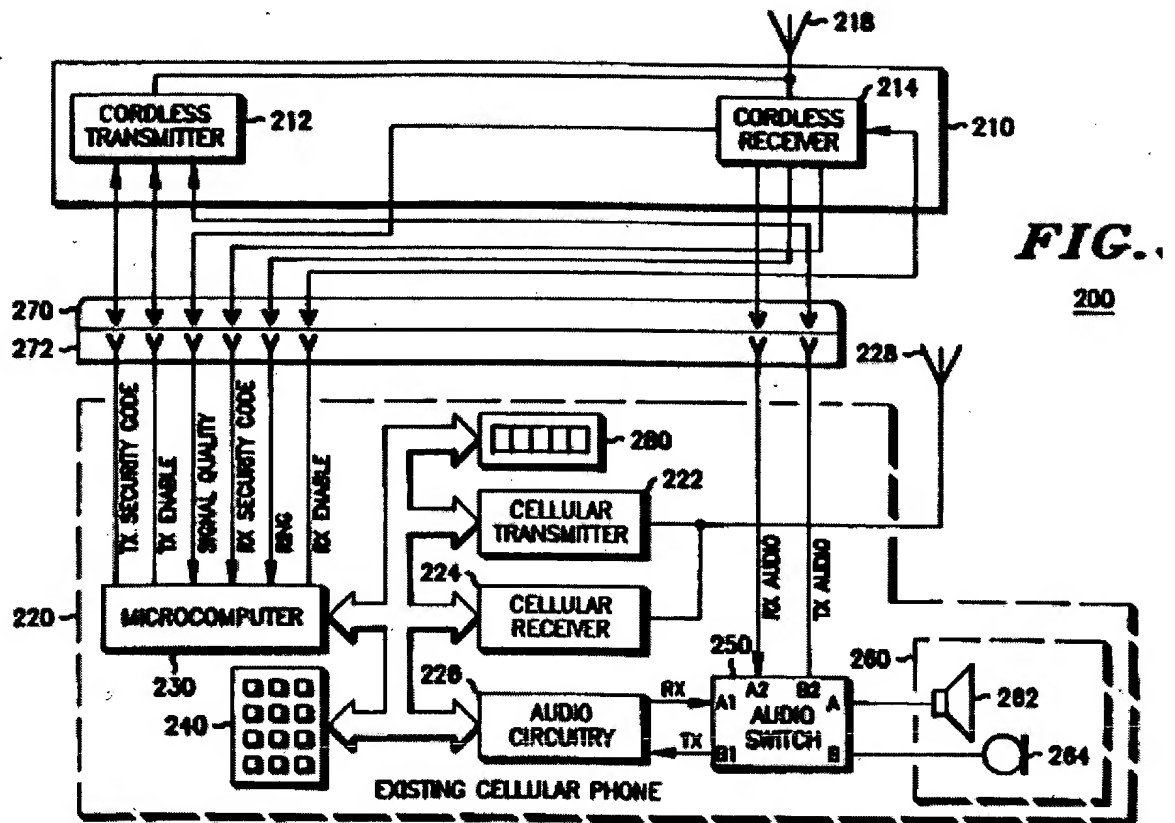
2. The requirement is still deemed proper and is therefore made **FINAL**.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 45, 46, 49, and 58 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by **Gillig, et al.**

Gillig, et al disclose an apparatus (figure 3) for selecting one of plurality of transmission systems (figure 1, #180, 188, 190) having a connector (#270, 272) for connecting the device to a first transmission interface (#210). A second transmission system (#222) provided as an integral component of the device. A detector (#214, 230) for detecting the presence of a first transmission system and a control system for selecting the first transmission system (#230, 226, 250, note figure 5, etc.) whenever it is present and selecting the second default system whenever the first transmission is not present (#408, etc.).



5. Claims 45, 46, 47, 48, 49, 56, and 58 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by **Young, et al.**

Young, et al disclose an apparatus (figure 5) for selecting one of plurality of transmission systems (wired, wireless) having a connector (#172) for connecting the device (#101) to a first transmission interface (#556, 558, 141, 562, 564, 139, 135, 137). A second transmission system (#507, 115) provided as an integral component of the device (#101). A detector (#560) for detecting the presence of a first transmission system (wired) and a control system for selecting the first transmission system (wired) whenever it is present and selecting the second default system (wireless) whenever the first transmission (wired) is not present.

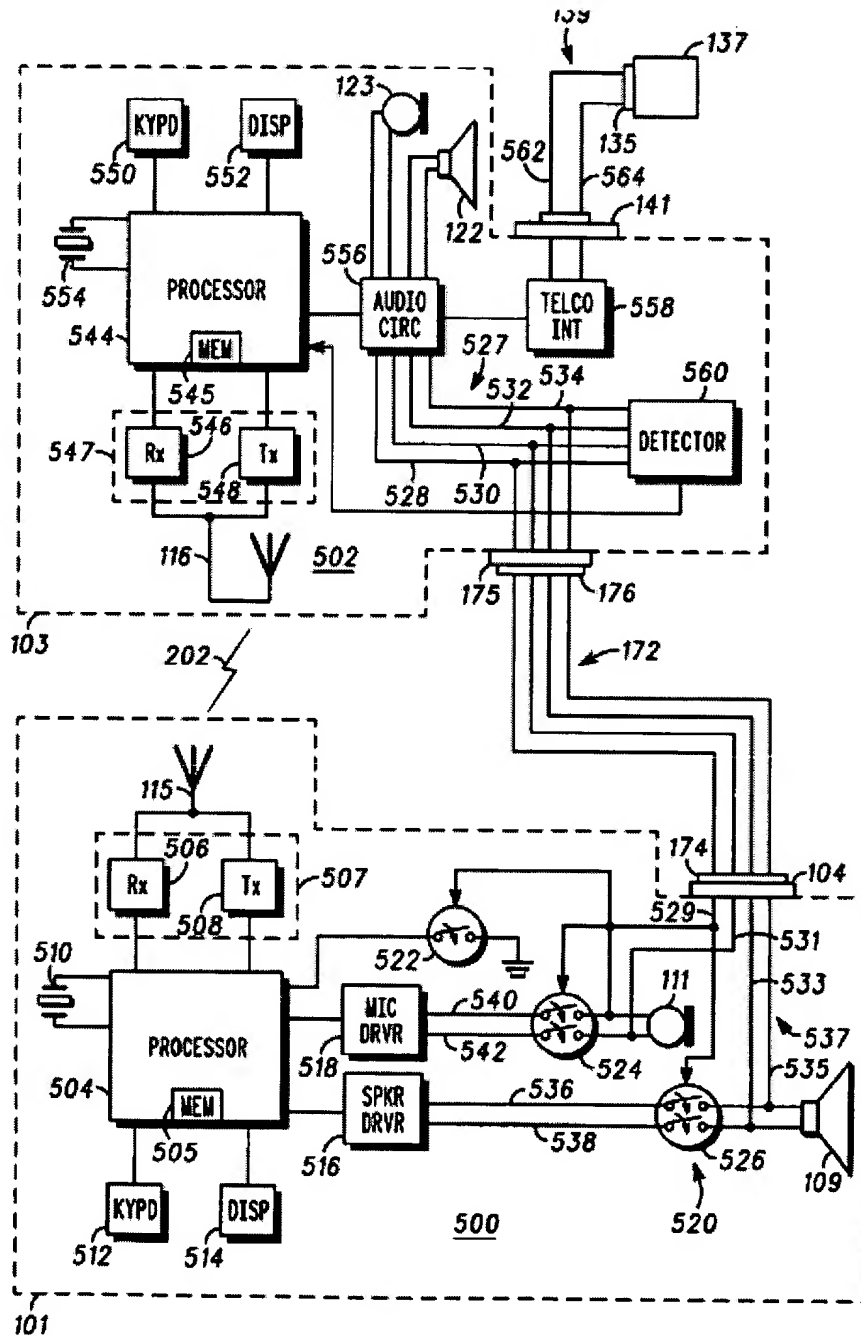


FIG. 5

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gillig, et al** or **Young, et al** in view of **Bennett, III, et al**.

An Ethernet connection instead of a tip and ring interface, or a standard telephone interface, is old and well know in the art and the examiner takes Official notice as such. The examiner also cites **Bennett, III, et al** as evidence as such. Hence, it would have been obvious to one below ordinary skill in the art at the time the claimed invention was made to incorporate the old and well know use of an Ethernet connection in the apparatus of **Gilleg, et al** or **Young, et al** in order to connect to an Ethernet network which has increase bandwidth for digital and voice data and other services.

Response to Arguments

10. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new grounds of rejection.

Applicant should submit an argument under the heading "*Remarks*" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday - Friday 10:30am to 8:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **DAINIEL HUNTER** can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Art Unit: 2684

Non-Final Rejection.doc 11/4/02 10:44 PM

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

WILLIAM D. CUMMING
Primary Examiner
Art Unit 2684

wdc
November 4, 2002



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